

-2-

REMARKS

To date, the Examiner has not indicated that the subject matter of the information disclosure statement (IDS) filed February 4, 2005 has been properly considered. A copy of such IDS is submitted herewith. If the Examiner requires additional copies of any reference(s), applicant invites the Examiner to contact the undersigned. Documentation in the file wrapper of the instant application confirming the Examiner's consideration of the relevant reference(s) is respectfully requested.

The Examiner has stated that Claims 15, 17 and 34 which were rejected under 35 U.S.C. 103(a) were not addressed by applicant. Applicant respectfully asserts that the rejection of such claims were properly addressed by virtue of the foregoing claims' dependency on the pending independent claims (which were argued to be allowable). Note applicant's statement at the bottom of page 13 of the last Amendment dated 06/3/05, which argue that "all of the independent claims are deemed allowable. Moreover, the remaining dependent claims are further deemed allowable, in view of their dependence on such independent claims."

The Examiner has rejected Claims 1—10, 12-14, 16, 18-30, 32-33, and 35-39 under 35 U.S.C. 102(b) as being anticipated by Ji et al. (U.S. Patent No.5,889,943). Applicant respectfully disagrees with such rejection.

With respect to independent Claims 1, 24, 28 and 36, the Examiner has relied on the following excerpt from Ji to make a prior art showing of applicant's claimed "prior to the certain electronic file being made available for viewing by the intended recipient, converting the certain electronic file to a second file format having a second file extension that is different from the first file extension of the first file format and that prevents the computer virus from executing when the converted electronic file is opened by the intended recipient" (see this or similar, but not identical, language in each of the foregoing claims).

"...the mail sending module 281 may be used to forward messages or attachments to parties such as the sender and recipient of the treated message or the network administrator." (Col. 18, line 1-4)

-3-

In the latest Office Action, dated 08/19/05, the Examiner has argued that Ji's teaching of renaming files (Col. 9, lines 1-44) meets the foregoing limitations. Specifically, the Examiner has simply concluded that renaming a file determined to have a virus, as taught in Ji, is the same as converting the file to a different file format. Applicant respectfully disagrees. First, renaming a file simply means giving the file a new name. Applicant claims converting the file to a different file format, and not merely giving the file a new name as taught in Ji. Specifically, nowhere in Ji is there any teaching of giving the file a different extension (e.g. .TXT, etc.) as suggested by the Examiner. Such extension, which is separate and different from a file name, is indicative of a format thereof.

Second, Ji also fails to disclose converting the file into a different file format "that prevents the computer virus from executing when the converted electronic file is opened by the intended recipient." It seems the Examiner has simply inferred such a teaching from Ji, since the Examiner has failed to precisely show where such disclosure can be found. Applicant respectfully asserts that such an inference is unfounded. Specifically, in Ji, when a virus is found in a file three options are provided, namely doing nothing and transferring the file, deleting the file without transferring it, or renaming the file and storing it (see Col. 9, lines 39-44). Thus, since Ji allows for a file to be transferred even after determining that the file is infected, it is inappropriate to assume that renaming a file would include converting the file into a different file format "that prevents the computer virus from executing when the converted electronic file is opened by the intended recipient," as claimed by applicant.

As argued in the last Amendment filed 06/3/05, it seems that the Examiner has relied on Ji's disclosure of sending mail messages that have been treated to meet applicant's specific claim language. Applicant respectfully asserts that Ji's "treated message" is simply a message that contained a virus and that was cleaned (see Col. 17, lines 34-52 for example). Thus, Ji merely teaches sending a message after it has been cleaned of any virus infection, which clearly does not meet "converting the certain electronic file to a second file format having a second file extension that is different from the first file extension of the first file format and that prevents the computer virus from executing when the converted electronic file is opened by the intended recipient" in the manner claimed by applicant. Specifically, applicant claims changing the format of a file

-4-

such that the virus contained in the file is prevented from executing, which clearly distinguishes the cleaning of the file as disclosed in Ji.

Still with respect to independent Claims 1, 24, 28 and 36, the Examiner has relied on the following excerpt from Ji to make a prior art showing of applicant's claimed "wherein it is determined whether the certain electronic file represents at least a potential risk to security of a computer system, said converting the certain electronic file being in response to a determination that the certain electronic file represents at least the potential risk to the security of the computer system" (see this or similar, but not identical, language in each of the foregoing claims).

"...the mail scanning apparatus may then take corrective action 1225 regarding the infected message, by either removing the virus, sending a warning as part of the message, deleting the message or forwarding the message to a system administrator." (Col. 18, lines 47-51)

In the latest Office Action dated 08/19/05, the Examiner has failed to address applicant's specific arguments from the Amendment dated 06/3/05. In view of the Examiner's arguments with respect to applicant's claimed "converting the certain electronic file to a second file format that is different from the first file format and that prevents the computer virus from executing when the converted electronic file is opened by the intended recipient," applicant respectfully asserts that Ji does not teach the present claim language for substantially the same reasons as argued above.

As argued in the last Amendment filed 06/3/05, applicant respectfully asserts that the corrective actions disclosed by Ji, namely removing a virus, sending a warning with the message, deleting the message and forwarding the message, clearly fail to teach "converting the certain electronic file being in response to a determination that the certain electronic file represents the potential risk to the security of the computer system," as claimed by applicant. Specifically, applicant claims converting the file format, as described in the remaining claim language, whereas Ji merely cleans the infected file or leaves the file "as is."

The Examiner is reminded that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. Of California*, 814 F.2d 628, 631, 2 USPQ2d 1051,

-5-

1053 (Fed. Cir. 1987). Moreover, the identical invention must be shown in as complete detail as contained in the claim. *Richardson v. Suzuki Motor Co.* 868 F.2d 1226, 1236, 9USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim.

This criterion has simply not been met by the Ji reference, for the reasons noted above. A notice of allowance or a specific prior art showing of all of applicant's claim limitations, in combination with the remaining claim elements, is respectfully requested.

Applicant further notes that the prior art is also deficient with respect to the dependent claims. For example, with respect to dependent Claim 14, the Examiner has relied on the following excerpts from Ji to make a prior art showing of applicant's claimed "receiving a second electronic file intended for delivery from another sender to another intended recipient, the second electronic file having a third file format and containing another computer virus; and prior to the second electronic file being made available for viewing by the another intended recipient, converting the second electronic file to a fourth file format that is different from the third file format and that prevents the another computer virus from executing when the converted second electronic file is opened by the another intended recipient."

"The messages may contain simple text, graphics files or complex executable files which, as indicated, may carry viruses." (Col. 13, lines 22-23)

"...which may be of various types such as files generated by the electronic mail program 292 text editor, files generated by network application programs 296 such as word processing or spread sheet files, executable files, or any other object or item which may be conventionally attached to an electronic mail message or transferred to the client node 230 in an electronic mail system 200." (Col. 14, lines 32-38)

In the latest Office Action dated 08/19/05, the Examiner has again relied on Ji's teaching of renaming a file (Col. 9, lines 1-44) to meet applicant's specific claim language. For substantially the same reasons as argued with respect to each of the independent claims above, applicant respectfully asserts that simply renaming a file does not meet "converting" in the context claimed by applicant.

-6-

As argued in the last Amendment filed 06/3/05, applicant respectfully asserts that the above excerpts from Ji merely teach the type of messages that may carry viruses and the types of attachments that may be attached to such messages. Clearly, the above excerpts do not even suggest any sort of preventing virus execution in an electronic file, let alone in the specific manner claimed by applicant. Furthermore, nowhere in Ji is there any mention of "converting the second electronic file to a fourth file format that is different from the third file format and that prevents the another computer virus from executing when the converted second electronic file is opened by the another intended recipient," in the context claimed by applicant (emphasis added).

With respect to dependent Claims 16-18, the Examiner has relied on Ji's disclosure of ".txt, .bmd, .pcx and .gif extension files" (Col. 8, line 67) and "encod[ing] binary data to ASCII data" (Col. 11, line 59) to make a prior art showing of applicant's claimed "second file format being at least one of a TXT file format, a RTF file format without embedded objects, a BMP file format, a JPEG file format, a CSV file format, a JPB file format, a GIF file format, a HTML file format without scripts, and a ASCII file format" (Claim 16), "second file format being the HTML file format without scripts" (Claim 17), and "second file format being the ACSII file format file" (Claim 18).

In the latest Office Action dated 08/19/05, the Examiner has argued that the types of files claimed by applicant are mentioned in Ji (Col. 8, line 67, Col. 9, lines 1-2). However, applicant notes that such excerpts merely disclose types of files likely to contain viruses and types of files not likely to contain viruses. In Ji, if the file is of a type that is likely to contain a virus, then the file is temporarily stored and analyzed to determine if it has a virus (see Col. 9, lines 14-20). Thus, the file formats determined in Ji only relate to determining whether to further analyze a file for viruses, and not to actually converting the file format, in the specific context claimed by applicant.

As argued in the last Amendment filed 06/3/05, applicant respectfully asserts that simply disclosing types of files does rise to the level of specificity of applicant's claim language. In fact, the excerpts relied on by the Examiner are in the context of checking extensions of file names (Col. 8, line 66) and scanning messages for portions that have been encoded using

-7-

uuencode (Col. 11, line 58). Clearly, neither of these contexts meet applicant's specific claim language, since applicant claims converting a first file format to a second file format, where the second file format is "at least one of a TXT file format, a RTF file format without embedded objects, a BMP file format, a JPEG file format, a CSV file format, a JPB file format, a GIF file format, a HTML file format without scripts, and a ASCII file format" (Claim 16), "the second file format [is]... the HTML file format without scripts" (Claim 17) or "the second file format [is]... the ASCII file format" (Claim 18).

With respect to dependent Claim 22, the Examiner has relied on the following excerpts from Ji to make a prior art showing of applicant's claimed "determining if the first file format is one of a word processing file format type and a graphics file format type, the second file format being at least one of a TXT file format, a RTF file format without embedded objects, and a HTML file format without scripts if it is determined that the certain file format is the word processing file format type, the second file format being at least one of a JPB file format, a BMP file format, a GIF file format, a HTML file format without scripts, and a JPEG file format if it is determined that the first file format is the graphics file format type."

"The analysis here is the same as step 618. In step 652, the output of the virus checking program is preferably echoed to the client task 72 by the FTP proxy server..." (Col. 10, lines 30-33)

"...the FTP proxy server 60 and SMTP proxy server 62 are preferably only included or installed in the memory 44 of the gateway nodes 33." (Col. 6, lines 50-53)

In the latest Office Action dated 08/19/05, the Examiner has again argued that the types of files claimed by applicant are mentioned in Ji. As argued with respect to the Amendment dated 06/3/05, applicant respectfully asserts that the above excerpts from Ji simply disclose an FTP proxy server that echoes the output of a virus checking program to a client task. Clearly, such a teaching has no relation to any sort of converting, in the manner claimed by applicant, and thus can in no way meet the same.

Since the Ji reference fails to teach all of applicant's claim limitations, as noted above, a notice of allowance or a specific prior art showing of all of applicant's claim limitations, in combination with the remaining claim elements, is respectfully requested.

-8-

Thus, all of the independent claims are deemed allowable. Moreover, the remaining dependent claims are further deemed allowable, in view of their dependence on such independent claims.

In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 505-5100. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 50-1351 (Order No. NAI1P092/01.050.01).

Respectfully submitted,
Zilka-Kotab, PC.

Kevin J. Zilka
Registration No. 41,429

P.O. Box 721120
San Jose, CA 95172-1120
408-505-5100